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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/825,610

04/16/2004

Ashok Tehim

MEMORY-0040

8058

24980 7590 05/01/2009
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EXAMINER

SAEED, KAMAL A

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

05/01/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Claims 1-3 and 5-7 have been canceled. Claims 37-46 have been added.

Therefore, claims 4 and 8-46 are currently pending in this Application. Claims 12-27 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference, which anticipates one group, would not render obvious the other.

Previous Rejections/Applicants Argument

Claims 4, 8, 30-36, were provisionally rejected under the judicially created doctrine of obviousness-type double patenting over claim 4 of co-pending U.S. Application No. 11/253,812. Since claim 4 is now canceled in '812 Application, the rejection is moot. Therefore, the double patenting rejection is hereby withdrawn.

Claims 4, 8-11, 28-46 were rejected under the judicially created doctrine of obviousness-type double patenting over claim 4 of co-pending U.S. Patent No. 7,235,579 as set forth in the previous office action. Applicants argument filed February 06, 2009 have been considered but was not found to be persuasive to the overcome the rejection. Applicants admit that claim 4 of US '579 recite that R5 can also be a heterocyclic group but argue that the claims of '579 do not lead one skilled in the art to the R5 recited in the proviso clause of applicants' claim 4. The examiner carefully considered applicants argument but respectfully disagree for the following reason. MPEP § 2144.08.11.A.4(c) states "... consider teachings of a preferred species within

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the genus. If such a species is structurally similar to that claimed, its disclosure may motivate one of ordinary skill in the art to choose the claimed species or subgenus from the genus, based on the reasonable expectation that structurally similar species usually have similar properties". This is the "Genus- Species Guidelines" for examination based on 35 USC 103 and an analogous guideline was followed here for the analysis of obviousness-type double patenting. Therefore, it would have been obvious to one of ordinary skill in the art to make (at least some of) the compounds and compositions of the instant application given U.S. Patent No. 7,235,579. Therefore, the instantly claimed compounds would have been suggested to one skilled in the art.

Therefore, the obviousness-type double patenting rejection as set forth in the previous office action is maintained. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamal A Saeed whose telephone number is (571) 272-0705. The examiner can normally be reached on M-T 7:00 AM- 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

Communication via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or public PAIR only. For more information about the pair system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

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/Kamal A Saeed, Ph.D./

Primary Examiner, Art Unit 1626